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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,656	11/12/1999	NICHOLAS J. ELSEY	1631077-0028	4745

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

22

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,656

Applicant(s)

ELSEY ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-25, 28, 29, 41-44, 46-50, 53, 54, 66-69 and 71-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-25, 28, 29, 41-44, 46-50, 53, 54, 66-69 and 71-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments, in the telephonic interview on 7/24/03, with respect to claims 22 and 41 have been fully considered and are persuasive. The 112 rejection of claims 22 and 41 has been withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 22 – 25, 28, 41 – 44, 46 - 50, 53, 66 – 69, 71 – 75, 78 – 86, and 89 – 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden) and further in view of US Pat Pub 2002/0078004 (Ambrosini et al.)

As to claims 22, 41, 47, and 66, Cox et al. teach a method and apparatus for providing directory assistance wherein an initiator of the communication connection is associated with various data elements as claimed, those elements being either ANI, area of the caller's origination, the caller's identity, etc. and is identified based on that data. Of course with data elements such as those noted, it is inherent that there must be a data source where such elements can be stored and accessed. Furthermore, depending on the type of service the caller desires, whether it be retrieval of a desired telephony number or the leaving of a message or the paging of an unreachable destination party, the caller's right to access or have that particular service performed is first verified. If the caller is verified and has the authority to make the desired call, receive/use the desired information, the appropriate actions are taken. (Page 1, paragraphs 0004 – 0005 and 0008, Page 2, paragraphs 0012 – 0016, Page 3, paragraphs 0036, Page 4, paragraph 0044 – Page 7, paragraph 0072)

Cox et al. has been discussed above but does not teach explicitly the editing and deletion of directory information or simply a directory although Cox et al. does teach a caller/subscriber being able to provision certain preferences.

However, Darden teaches a personal electronic directory allowing or the creation, editing, deletion, and general manipulation of one's personal directory. Including such flexibility in the system of Cox et al. would be obvious to one skilled in the art inasmuch as Cox et al. already teach being able to access different types of directories and databases. Including a personal, editable directory would simply be extending the invention of Cox et al. to access just another type of directory and giving

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the caller/subscriber more authority. Again, because Cox et al. already teach making certain features of the system programmable/customizable to a specific caller/subscriber, such would be obvious to one skilled in the art. Lastly, the trend of telecommunications has always been and continues to be one which gives the personal user/caller/subscriber more flexibility with their own services, to give them more control. Such reasoning too would make it obvious to combine the teachings of Cox et al. and Darden. (Abstract, Col. 2, lines 39 – Col. 3, line 50, Col. 5, line 8 – Col. 10, line 26 of Darden)

Furthermore, as taught by Ambrosini et al. it is old and well known to allocate various levels of access to directory services such as directory assistance wherein the different levels of user access to information in directory assistance are defined in the Bellcore F20 Specification (BR 754-110-103, Issue 8, September 1998, Rev. 1, March 1991). (P. 4, ¶ 0039 of Ambrosini et al.) Also allocating different levels of access to directories can even be seen various computer arts wherein certain file directories or folders are given different levels of access. As mentioned above, the data source is inherent in such a system and would also be inherent in any system having different levels of access. There must be some data source where users can be identified as having those different levels of access. Material that is not technically prior art can be relied upon as evidence of the skill level in the art as of about the date of invention, e.g., a later dated publication, *Gould v. Quigg*, 3 USPQ2d 1302 (Fed. Cir. 1987).

Furthermore, Cox et al. and Darden do not teach connecting an initiator to the selected data element even if disclosure is prohibited.

However, such is a very old and common procedure. An example of this would arise when calling the Director of the USPTO. A secretary who handles the incoming telephone calls is used basically to screen calls and could decide to connect a person to the Director without giving that person the actual/direct telephone number of the Director. If one merely calls a corporation and asks for a telephone number of an employee, many times, the operator will not give out the telephone number but will agree to connect the person. This is done for many reasons. One is simply because, if the desired telephone number was given out, there would be no way to screen callers since they could call at anytime bypassing the operator or secretary. This is a common motivation and would have been an obvious feature to include in the invention of Cox et al. by one of ordinary skill in the art.

As to claims 23 – 25 and 48 – 50, Cox et al. teach a directory assistance means and method wherein the information sought by the caller is information concerning an individual such as a telephone number or address or even groups such as information regarding/coming from business directories as opposed to private individuals. Moreover, inherent in Cox et al. or any other directory assistance system for that matter is reading the selected data element, otherwise there would be no other way to ascertain the data and present it to the caller or even simply to retrieve it, the data element must be read. And of course as already mentioned accessing a data source where those data elements are stored and accessed (See above references to Cox et al.)

As to claims 28, 42 – 44, 46, 53, 67 – 69, and 71, of course the communications service would include a voice communications service as taught by Cox et al. The present invention as well as Cox et al. and most any other standard directory assistance means and method would have to include a communications service that included making a telephone connection. Simply getting access to the directory assistance system would entail having to use a voice communications system and having to make a telephone connection. Moreover, see Fig. 1 and Data servers 120a for example which are analogous to the claimed "database[s] includ[ing] a directory." As already discussed above, the invention of Cox et al. is a directory assistance system. As also discussed above, Cox et al. teach verifying the authority of a caller to access certain desired information and/or to have those calls completed by the directory assistance system. (See above references to Cox et al.)

As to claims 76, 77, 87, and 88, see P. 6, ¶ 0064 of Cox wherein it is explicitly taught that either a live operator or voice server may be used.

3. Claims 29 and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden) and further in view of US Pat 6,404,884 (Marwell et al.)

Cox et al. and Darden have been discussed above, but do not discuss the initiator establishing an internet connection. However, telephony and the internet are well known to now be blended in this and many other types of art. Telephone calls can be made via the internet, call centers may be accessed using both a computer/internet

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and a standard POTS telephone. Inasmuch as this is the case, it would have been very obvious for one skilled in the art to have allowed access to the claimed present system via the internet. Many services operate this way presently as it just is another way of accessing the service and nothing more. Moreover, Marwell et al. teach accessing and manipulating a personal contact list, which is analogous to the above-discussed personal directory, via the web. (Abstract, Figs. 5 – 13, Col. 5, line 9 – 24 of Marwell et al.)

Also, the above-mentioned ANI data element is essentially a calling party's telephone number.

Response to Arguments

4. Applicant's arguments filed 3/4/03 have been fully considered but they are not persuasive.

As to applicant's arguments, the issues have been addressed above.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat 6,076,093 (Pickering) teaches a real-time interact directory giving different levels of access to different users. US Pat 6,147,773 (Taylor et al.) teach a system and method for a communication system having differing levels of access for different users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

H.A.A.
September 22, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to be 'Fan Tsang', written over a horizontal line.